REMARKS

Attached to these remarks is an informal drawing which applicant's attorney intends to add to the application. The adding of Fig. 6 necessitates a number of changes in the specification which have been requested above. In addition claims 24, 34 and 39 have been amended and claims 28 and 38 have been cancelled.

Applicant wishes to direct the Examiner's attention to the fact that there are two major changes in Fig. 6 as compared with Fig. 1. Fig. 6 is a drawing of the downstream end of a drying section which includes only top felted single-tier (i.e., normal) dryer groups, Fig. 6 shows only the last two groups in the section, whereas Fig. 1 shows a portion of a dryer section which includes a normal group and an inverted group. The only other feature of Fig. 6 not shown in Fig. 1 is the location of a device 52 for applying heat and moisture to the paper web W at the exit end of the dryer section. Neither of these features is new matter as each was described in the original patent as filed and as issued.

Thus, with respect to the first feature of Fig. 6 not shown in Fig. 1 but clearly described in the specification, the Examiner's attention is respectfully directed to page 6 of the specification beginning at line 8 which reads:

> "In a preferred embodiment of the invention, a drying group is accomplished in which, as groups with single-wire draw, exclusive so-called normal groups are used, in which the heated drying cylinders, against which whose faces the web W is in direct contact, are placed in the upper row as in the case in Fig. 1 in respect of the cylinders in the group R2"

Please note in this passage the preferred form of the invention is a drying section made of all groups that are "so-called normal groups", in which the heated drying cylinders, against whose faces the web W is in direct contact, are placed in the upper row..."

Fig. 6 shows the exit end of such a preferred drying section. That is each dryer group in the drying section of Fig. 6 is a so-called normal group with the drying cylinders placed in the upper row and the vacuum or suction rolls in the lower row. Thus, there is no new matter in Fig. 6 with regard to the inclusion of an all normal dryer group dryer section, it having been fully described in the original patent specification as filed and as issued.

As to the second feature of Fig. 6 that was not previously illustrated in the drawings, it is the location of a means 52 for supplying moisture and temperature to the web W at the exit end of the dryer section. Specifically, as may be seen in Fig. 6, it is placed against the final vacuum roll 22 in the last dryer group in the illustrated drying section.

This placement of the means 52 at the exit end of the drying section is specifically described in U.S. Patent No. 5,416,980 in page 7, beginning in line 31 as follows:

> "Steam boxes 30 in accordance with the invention can be placed as a necessary number along the drying section. The steam boxes in accordance with the invention are most useful when employed at the final end of the drying section." [Emphasis Added]

Thus there is a clear description of what the preferred placement of the steam box is and that is at the exit end of the drying section.

In light of the fact that the only features shown in Fig. 6 that were not illustrated in original Figures 1-5 are features that are clearly described in the original specification, the inclusion of such previously described features in a new drawing, Fig. 6, does not constitute new matter. Accordingly, the Examiner is respectfully respect to withdraw her rejection based on §112 and to allow the entry of Fig. 6.

Turning now to the Examiner's rejection based upon the Recapture Rule, the Examiner points to two aspects of the claims added to the reissue application as constituting a

recapture. One relates to the fact that some of the added claims do not include any specific reference to steam or steam generators or steam boxes but to the application of heat and temperature, and the other related to the inclusion in claims 26 and 34 of the term guide rolls which is not limited to suction guide rolls. As to the recapture rejection based upon the omission of the term "suction" as applied to the guide rolls, the Examiner will note that claims 26 and 34 have now been amended to limit the guide rolls of claims 26 and 34 to "suction guide rolls", thereby obviating the Examiner's basis for a recapture rejection.

Turning our attention now to the Examiner's recapture rejection based on the fact that some of the claims added by this reissue, specifically claims 26, 29, 30, 31, 33, 34, 36, 37 and 41 are all directed to either the application of heat and moisture without reference to the nature source or are not limited to the inclusion of a steam box. It is the Examiner's contention that this constitutes a recapture of subject matter previously given up during the prosecution of the original patent. Applicant respectfully disagrees with the Examiner and submits that nowhere in the original patent did the applicant surrender the right to claim subject matter calling for the application of heat and moisture without reference to the use of steam. Applicant's attorney does not deny that in this respect, the claims added by reissue are broader than the claims as originally filed and ultimately issued in the original patent but this reissue application is, as to this feature, a broadened reissue application filed within two years of the issue date of the original patent, all as contemplated by 35 U.S.C. 251.

Applicant's attorney respectfully asserts that the mere fact that a claim in the reissue is somewhat broader in scope then the claim in the original application or the original patent does not give rise to a recapture. This would clearly violate the terms of 35 U.S.C.

251. As the CAFC stated in *In re Clement*, 131 F 3d. 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) at page 1164 of 45 USPQ2d:

> "The second step [in determining if there has been a recapture] is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection (cites omitted)"[Emphasis Added]

A review of the prosecution history of the original patent, 5,416,980 establishes that the applicant, during the prosecution of the application resulting in the patent, never surrendered the right to claim the application heat and moisture without regard to the use of a steam generator as the source. A study of the application as originally filed established that there were 17 claims originally presented. Every one of them was directly or indirectly limited to there being steam or a steam box present to produce heat and moisture. In the Amendment of February 25, 1993 (Amendment A), while claim 1 was amended to more specifically define where in the apparatus the steam is applied and by what specific steam producing means, there was no attempt to broaden the claim to eliminate the limitation that the application of heat and moisture comes from steam. Likewise, in claim 8 which originally called for a steam box for applying steam to the web, in Amendment A there was a limitation added to claim 8 defining the mode of application and control of the steam box but there was no attempt to broaden claim 8 by eliminating any reference to the fact that the source of temperature and moisture was steam. Similarly, in claim 18, which was a new claim added by Amendment A, the claim from its inception called for applying steam to the paper web. This is likewise true of claim 22 which was also added by Amendment A. Thus, in Amendment A there was no attempt to broaden the claims by getting rid of the concept that steam was a necessary source of moisture and temperature nor was there any narrowing of these claims down to steam or steam box.

This is likewise true in Amendment B dated September 15, 1993. There are amendments to claim 1 in Amendment B but they have nothing whatsoever to do with attempting to broaden the claim by eliminating any reference to steam as to a source of temperature and moisture and this is likewise true of claim 8, 12, 14, 18 and 22. While additional claim 23-29 were also added in Amendment B, none of them represents an effort by the applicant to broaden his claims to eliminate steam as the source of temperature and moisture nor to narrow the claims down to steam or steam box.

Turning now to Amendment C dated April 25, 1994, claim 1 was amended in Amendment C but there was no effort whatsoever to remove the limitation that steam was what was applied to the web to control its temperature and moisture content nor to add such limitation. As to this subject matter, claim 1 remained unchanged. Likewise, claim 8 was amended in Amendment C but the amendment related to controlling the application of steam, not to adding it or eliminating it. Claim 18 was also amended in Amendment C to specifically recite the surface of the web to which the steam was applied. There was no effort to add or eliminate the concept of using steam as the source of temperature and moisture. This is also true of claim 22 which calls for raising the temperature of the bottom side of the web by applying a sufficient amount of steam. New claim 30 was added in Amendment C and this had the same language concerning where steam was to be applied as in claim 22.

Finally, Amendment D was entered on October 26, 1994. This Amendment D only amended one claim, originally numbered claim 8, now patent claim 6. The claim was amended to define the position of the "steam box end" in the drying section, not to try to broaden the claim by eliminating any reference to steam or a steam box nor to narrow the claim to add steam or steam box.

From the foregoing it will be seen that throughout the lengthy prosecution of the original patent, the applicant/patentee never once attempted to present a claim that was not limited to the use of steam as the medium by which the temperature and moisture was applied to the web. It was always steam. There is no amendment in this entire prosecution history which can be said to narrow a claim not originally limited to the use of steam to one calling for steam as the medium for the application of temperature and moisture to the web which would constitute a surrender of subject matter broader than the use of steam as such medium. Since the subject matter of the source of temperature and moisture by other than steam was never surrendered by narrowing any such claim, to the steam, subject matter of such medium is not subject to the concept of recapture.

Specifically, there is no surrender present in the original patent prosecution history which applicant could possibly be attempting to recapture by eliminating reference to steam in the claims added by this reissue. All the elimination of reference to steam has been done in applicant's reissue application to broaden the reissue which applicant has every right to do so long as such broadening does not constitute a recapture subject matter which applicant surrendered during the prosecution of the original patent. *In re Clement Id.*

In view of the foregoing, it is respectfully submitted that applicant has now fully complied with §112 in that all claimed subject matter is supported by the drawings, including Fig. 6, and that Fig. 6 includes no new matter, and further that the absence of any reference to steam in the newly added claims of this application does not constitute a recapture. In view of the foregoing reconsideration and allowance of all claims are respectfully requested.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By _____

Myron Cohen
Reg. No. 17,358
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: February 6, 2002

COPY OF PAPERS
ORIGINALLY FILED

AMENDMENTS TO THE SPECIFICATION AND CLAIMS SHOWING CHANGES

IN THE CLAIMS:

Please cancel claims 28 and 38, and amend claims 26, 34 and 39 as follows:

--26. A method of reducing the tendency of a paper web to curl in a paper machine, comprising the steps of:

asymmetrically drying the paper web in its thickness direction extending between the top and bottom sides of the paper web to a solids content at which curl-inducing stresses are formed in the paper web by passing the paper web through a plurality of top-felted single-tier normal dryer groups, each of said plurality of normal dryer groups including a single tier of dryer cylinders, a plurality of suction guide rolls disposed below and between said dryer cylinders, and a single wire transporting said web over the dryer cylinders and beneath the guide rolls so that only the bottom side of said web engages said dryer cylinders; and

subsequently applying sufficient heat and moisture to the asymmetrically dried paper web to relax said stresses in the fiber mesh of the paper web, to thereby control curling of the web.--

--34. A paper machine, comprising:

a dryer for asymmetrically drying a paper web in its thickness direction extending between the top and bottom sides of the paper web to a solids content at which curl-inducing stresses are formed in the paper web, said dryer including a plurality of top-felted single-tier normal dryer groups, each of said plurality of normal dryer groups including a single tier of dryer cylinders, a plurality of suction guide rolls disposed below and between said dryer

cylinders, and a single wire transporting said web over the dryer cylinders and beneath the guide rolls so that only the bottom side of said web engages said dryer cylinders; and

a device for applying heat and moisture to the asymmetrically dried paper web for relaxing said stresses to thereby control curling of the web.--

--39. The paper machine of claim 34, wherein said stresses in said fiber mesh of the paper web are formed [or likely to be formed] at a solids content of at least about 70%.--